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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,678	06/01/2000	Eric E. Ellingson	60191	4533

23735 7590 03/28/2003

DIGIMARC CORPORATION
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SUITE 100
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EXAMINER

PATEL, SHEFALI D

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 03/28/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/585,678

Applicant(s)

ELLINGSON, ERIC E.

Examiner

Shefali d Patel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 2 is does not have the label 202 as mentioned on page 6 line 11. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Figure 2 shows element 310, which is not mentioned in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because in Figure 3, all of the blocks are numbered and are referred to by numbers in the specification except for the block “user authenticated.” Please label this block (if appropriate) for ease of understanding of the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:

- a. Page 7 line 14 the word “RGG” ought to be replaced by “RGB.”

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 11, 15-18, 20-21 and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Tao (USPN 6,242,481).

With regards to **claims 1 and 11**, Tao discloses a method for capturing and encoding a user attribute in a media signal at column 4 lines 49-53 and at column 5 lines 54-58, comprising: a media signal capture device, capturing a user attribute of a user of the media signal capture device and encoding the user attribute (user attribute can be any input means as mentioned at column 6 line 56) into a medial signal (i.e., an image) captured by the media signal capture device at column 6 liners 52-61.

Regarding **claim 20**, Tao disclose all of the features recited in this claims as mentioned above in claims 1 and 11 further discloses a decoder at column 9 lines 58-65 and also in Figure 6 and respective portions in the specification.

With regards to **claim 2**, Tao discloses the user attribute that forms at least part of an auxiliary message and embedding the auxiliary message into the media signal at column 6 lines 62-67.

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Regards to **claim 3** which is representative of **claims 15 and 21**, Tao discloses a method including steganographically embedding the user attribute (that forms the auxiliary message) into the medial signal such that the message is substantially imperceptible to a human at column 12 lines 11-16.

With regards to **claim 4**, Tao discloses the medial signal is an image and the media signal capture device is a camera at column 6 lines 40-44.

With regards to **claim 5**, Tao discloses the media signal as a sequence of video frames and the medial signal capture device as a video camera at column 9 lines 19-24.

With regards to **claim 16**, Tao discloses the media signal capture device comprising a video recorder at data storage device 104 in Fig. 1A and at memory 354 in Fig. 1B (see the respective portion in the specification).

With regards to **claim 17**, Tao discloses the user attribute capture unit that includes an image sensor at column 5 lines 29-34.

Regarding **claim 18**, which is representative of **claim 24**, Tao discloses the user attribute as a voice recording at column 6 lines 55-56 (i.e., the data recorded for voice recognition).

With regards to **claim 25**, Tao discloses a computer readable medium at column 4 lines 54-56.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 19 and 22-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Tao in combination with DiMaria (USPN 6,148,091).

With regards to **claims 19 and 22**, Tao discloses a method of capturing and encoding a user attribute including information for voice recognition in a media signal at column 6 lines 53-55, suggests “any other input means” may be used. However, Tao does not expressly disclose the user attribute being the retinal scan data. DiMaria discloses the user attribute being the retinal scan data at column 3 lines 62-65. One of ordinary skill in the art would have been motivated to use the retinal scan data as a user attribute in place of the voice data taught by Tao because the retinal scan is a well known user attribute. Tao suggest using “any other input means” and to replace one well-known user attribute with another is of no patentable significance. Moreover, the use of retinal pattern rather than voice data allows the same image sensor (114, Fig. 1B) to capture both the media signal and user attribute.

With regards to **claim 23**, DiMaria discloses the user attribute comprising a fingerprint scan (i.e., epidermal topographical pattern) at column 3 lines 62-65. Note, Examples of epidermal topography include digital data of user's fingerprint, knuckle print, palm print, etc. Fingerprint is a well known user attribute in the art and hence one of ordinary skill in the art would have been motivated to use fingerprint in place of the voice data taught by Tao.

9. Claims 6-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tao in combination with DiMaria, and further in view of Hill (USPN 4,109,237).

Regards to **claim 6**, Tao discloses the media signal capture device is a digital camera at 195 in Fig. 1B. DiMaria suggests of using the retinal pattern scan but does not further disclose the details of retinal pattern scan. Neither Tao nor DiMaria expressly disclose capturing a retinal scan of the user through the eyepiece. Hill discloses capturing a retinal scan of the user through the eyepiece (Hill refers this to “viewing hood”) in Figure 3 (see the respective portion in specification at column 3 lines 19-27). DiMaria does not disclose the specific detail of retinal scan. Hill discloses the detail of the retinal scan including the eyepiece where user places their eye. One of ordinary skill in the art would have been motivated to use the eyepiece to have the eye at a fix position in order to scan the retina precisely.

Regarding **claim 12**, Tao discloses the media signal capture device as a digital camera at 195 Figure 1B. DiMaria discloses the user attribute capture unit as mentioned in claim 19 that captures the retinal pattern. Therefore, image sensor would have been a part of user attribute unit suggested by DiMaria and would have the same motivation as mentioned above in rejecting claim 19.

With regards to **claim 13**, Tao discloses image sensor 114 that captures the user attribute in Figure 1B. Further, DiMaria discloses the subject (i.e., identification document 10) image (the identification document reader 20 in Fig. 3 obtains the image) into which the user attribute is encoded (the identification information is encoded in element 16 as seen in Fig. 2).

Regards to **claim 14**, Tao discloses the user attribute that is encoded into the subject image in response to user input instructing the media signal capture device to capture the subject image at column 5 lines 12-24. By using the cursor, the user can trigger the media signal capture device instructing the user attribute to be encoded.

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With regards to **claims 7-10**, the recited features are the same as those in claims stated above, and the arguments in paragraph 6 above as to the relevance of Tao are incorporated herein.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6,321,981 – Method and apparatus for transaction card security utilizing embedded image data, hash algorithm is being described.

USPN 5,767,496 – Apparatus for processing symbol encoded credit card information, column 3-4.

USPN 6,389,151 – Printing and validation of self validating security documents

USPN 6,064,764 – Fragile watermarks for detecting tampering in images

USPN 4,015,240 – Convert scanner signal to digitally encoded image having many levels of gray scale data

USPG-PUB 2001/0055422 – System for reading 2D images using ambient and/or projected light, 2D image being the fingerprint image

USPN 5,841,886 – Security system for photographic identification

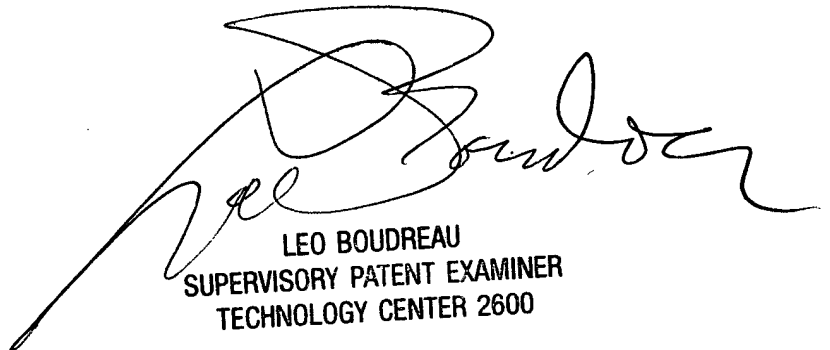
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali d Patel whose telephone number is 703-306-4182. The examiner can normally be reached on M-F 8:30am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

Shefali Patel
March 24, 2003



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